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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/761,864

01/20/2004

Richard Paul White

010-CON1

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36215

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10/05/2009

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EXAMINER

KANG, PAUL H

ART UNIT

PAPER NUMBER

2444

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/761,864	<b>Applicant(s)</b> WHITE ET AL.	
	<b>Examiner</b> Paul H. Kang	<b>Art Unit</b> 2444	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 October 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Status of Claims*

1. In light of the Pre-Brief Appeal Conference decision of July 17, 2009, prosecution is REOPENED. Claims 1-17 are pending.

### *Double Patenting*

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-17 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No.

**10/761,883**, claims 1-15 of copending Application No. **10/761894**, and claims 1-24 of copending Application No. **10/972,765**. Although the conflicting claims are not identical, they are not patentably distinct from each other because the context of the instant claims are the same as the

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context of the conflicting claims. The instant application and the copending applications all claim a system for rejecting or diverting spam messages by determining whether the message contains spam messages and diverting or terminating the connection of the transfer session.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-13 fails to fall within a statutory category of invention. The claimed “unsolicited message diverting communications processor” is directed to a software program itself, not a process occurring as a result of executing the program, a machine programmed to operate in accordance with the program, nor a manufacture structurally and functionally interconnected with the program in a manner which enables the program to act as a computer component and realize its functionality. It's also clearly not directed to a composition of matter. Therefore, it is non-statutory under 35 U.S.C. § 101. It is noted that “A networked computer comprising an unsolicited message diverting communications processor” would be statutory.

6. Claims 14-16 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. While the claims recite a series of steps or acts to be performed, a statutory “process” under 35 U.S.C. 101 must (1) be tied to particular machine, or

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(2) transform underlying subject matter (such as an article or material) to a different state or thing. See page 10 of In Re Bilski 88 USPQ2d 1385. The instant claims are neither positively tied to a particular machine that accomplishes the claimed method steps nor transform underlying subject matter, and therefore do not qualify as a statutory process. The claimed method including steps of waiting, relaying, intercepting, determining, etc. are broad enough that the claim could be completely performed mentally, verbally or without a machine nor is any transformation apparent. The examiner suggests, for instance, amending the “networked computer system” of claim 14 to a “networked computer.”

### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 16 and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Donaldson, US Pat. No. 7,249,175.

9. As to claims 16 and 17, Donaldson teaches a method and an apparatus comprising:

a) relaying and monitoring SMTP messages exchanged between a transmitting message transfer agent (MTA\_0) and a receiving message transfer agent (MTA\_I) (col. 8, lines 25-36);

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b) intercepting a RCPT reply from MTA\_0; c) determining if an e-mail message is unsolicited by analyzing the monitored SMTP messages (col. 40, lines 29-45; see also Figs. 13, 26 and 27; col. 15, lines 50-65; col. 3, line 57 - col. 4, line 2; in step 1656 and 1657 the recipient address is appended when the file is to be quarantined; see col. 42, lines 31-34 and 43-45); and

d) releasing the RCPT reply if the message is determined not to be unsolicited, whereas, substituting a diversion address for a to-address in the RCPT reply, creating a modified RCPT reply, and sending the modified RCPT reply to MTA\_1 if the message is determined to be unsolicited and if the to- address is in a save\_spam database (Once the RCPT command is received by the proxy, it is determined that a message is unsolicited and filtered accordingly; See Figs. 26 and 27; see also col. 40, lines 21-39, col. 3, lines 51-60 and col. 19, lines 23-26; Connection is rejected before the data portion is transmitted; See also Fig. 14 and col. 4, lines 3-8).

### ***Response to Arguments***

10. Applicant is invited to contact the Examiner to discuss possible claim amendment which may further prosecution of this patent application.

11. Applicant's arguments with respect to claims 1-17 have been considered but are moot in view of the new ground(s) of rejection. The applicants argued in substance that the prior art of record fails to teach an unsolicited message diverting communications processor comprising “substituting the diversion address A’\_1 for the to-address A\_1 in the RCPT reply and sending a modified RCPT reply to the MTA\_1” and further “does not intercept communications between

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MTA\_0 and MTA\_1 before a RCPT command from MTA\_0 is received by the unsolicited message diverting communications processor.”

The examiner respectfully disagrees. As seen in the cited passages above in reference to claim 1, Donaldson clearly teaches that the system does not intercept communications between MTA\_0 and MTA\_1 before a RCPT command from MTA\_0 is received by the unsolicited message diverting communications processor. See figs. 26 and 27; and col. 42, lines 31-34 and 43-45. Further, Donaldson teaches appending the recipient address when a message is determined to be unsolicited and otherwise to be quarantined. See Fig. 27 and col. 42, lines 4-60.

Applicant is reminded the definiteness of the language employed must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. Insofar, the claims have been given the broadest reasonable interpretation consistent with the specification and the prior art, since the applicant may then amend his claims, the thought being to reduce the possibility that after a patent is granted the claims may be interpreted as giving broader coverage than is justified. Therefore, applicant's arguments regarding various specific limitations such as “save\_spam database,” “diversion address A'\_1,” “to-address A\_1,” etc., are not given weight as to the patentability of the claimed subject matter. While the prior art may not explicitly use the same terminology as employed by the applicant, the features disclosed therein performs the same functions as that claimed by the applicant.

***Conclusion***

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul H. Kang whose telephone number is (571) 272-3882. The examiner can normally be reached on IFP.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Vaughn can be reached on (571) 272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Paul H Kang/  
Primary Examiner  
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